

REMARKS

In light of the above-amendments and remarks to follow, reconsideration and allowance of this application are requested.

Claims 1-11 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,266,403 (Ananikian et al.) in view of U.S. Patent No. 6,373,934 (Jensen). Applicant respectfully traverses this rejection.

Ananikian et al. describes a telecommunication comprising a detector for detecting a signalling signal. (col. 1, lines 5-10) However, Ananikian et al. does not teach or suggest a memorization or indication device that is operable to “memorize or indicate data relative to call duration as a function of the line state signal of the telephone line, thereby providing reliable data even when calls originate or terminate from or on another telephone on the telephone line,” as required in amended claim 1 and similarly in amended claims 10 and 11. In fact, col. 4, lines 19-30 of Ananikian et al., cited by the Examiner, merely describes that

“In case said regular user of telephone 3 has been away for a while ... said problem [of knowing whether the call has been answered by somebody else on telephone 3 or telephone 4 located in an other room] does not arise anymore, due to display 8 for example now either displaying both the number of the caller and a signal indicating that said call has been answered.”

That is, Ananikian et al. at best provides an indication that call has been answered on a secondary telephone. But, Ananikian does not teach or suggest providing information or data about the call, such as call duration, when it involves another telephone on the telephone line, i.e., call is answered on one telephone but continued on another telephone, as required in claims 1, 10 and 11.

Moreover, as admitted by the Examiner, Brandon fails to teach or suggest “a memorization device for memorizing data related to outgoing calls on a telephone line.”

(office action, page 2, paragraph 2) To cure this deficiency, the Examiner turns to Jensen.

Jensen describes a monitoring device for “providing an automatic printout of call data including parameters such as the date, time, and duration of a call, number dialed (outgoing calls), calling number (incoming calls).” (col. 1, lines 15-18) However, Jensen does not teach or suggest a telephone comprising a memorization or indication device that is operable to “memorize or indicate data relative to call duration as a function of the line state signal of the telephone line, thereby providing reliable data even when calls originate or terminate from or on another telephone on the telephone line,” as required in amended claim 1 and similarly in amended claims 10 and 11. In other words, Jensen fails to teach or suggest memorization or indication of data on telephone calls, such as call duration when a call is answered/called on/from one telephone but continued and terminated on another telephone connected to the same telephone line. Accordingly, the addition of Jensen does not cure the aforementioned deficiencies of Ananikian et al.

Accordingly, it is respectfully submitted that when one combines Ananikian et al. with Jensen, the results of such a combination still does not meet the terms of claims 1, 10 and 11 because neither reference teaches or suggests a telephone comprising a memorization or indication device that is operable to “memorize or indicate data relative to call duration, as a function of the line state signal of the telephone line, thereby providing reliable data even when calls originate or terminate from or on another telephone on the telephone line.”

In view of the foregoing differences, it is respectfully submitted that the combination of Ananikian et al. and Jensen does not render obvious claims 1, 10 and 11.

Further, the claimed invention defined by apparatus claims 1, 10 and 11 eliminates the shortcomings and disadvantages encountered with the prior art. Specifically, the claimed invention allows a telephone to accurately memorize and indicate data relating to incoming and/or outgoing calls, such as call duration, when calls involve several telephones connected to a single telephone line, i.e., a call is answered or made on one

telephone but continued and terminated on another telephone. It is undeniable that neither Ananikian et al. nor Jensen is even remotely concerned with the problem associated with the accurately memorizing and indicating data relating to incoming and/or outgoing calls when calls involve several telephones connected to a single telephone line. Since applicant has recognized a problem not addressed by the cited prior art and solved that problem in a manner not suggested by either Ananikian et al. or Jensen, the basis for patentability of the claims is established. See In re Wright, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988). There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner's rejection. "The problem solved by the invention is always relevant". Id. at 1962. See also, In re Rinehart, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

Absent evidence that the specific problem associated with the accurately memorizing and indicating data relating to incoming and/or outgoing calls when calls involve several telephones connected to a single telephone line was even recognized by the prior art, there can be no finding that the invention as a whole would have been obvious. As stated by the PTO Board of Appeals in Ex parte Breidt and Lefevre, 161 U.S.P.Q. 767, 768 (1968), "an inventive contribution can reside as well in the recognition of a problem as in a solution". It further appears that the conclusion reached by the Board of Appeals in Ex parte Minks, 169 U.S.P.Q. 120 (1969), is here in point. There, the Board concluded that "[a]ppellant having discovered the source of the problem and solved the same . . . he is . . . entitled to patent protection". Id. at 121.

In view of the foregoing authorities, it is submitted that, since neither Ananikian et al. nor Jensen is even aware of the problem addressed by applicant, and since the cited prior art reference does not suggest the solution defined by claims 1, 10 and 11, these claims are unobvious and patentably distinct over the combination of Ananikian et al. and Jensen. The allowance of claims 1, 10 and 11 is solicited for the reasons given above.

Furthermore, there is no motivation in Ananikian et al. or in Jensen to suggest that the teachings of these two references should be combined. In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988); In re Fritch, (Fed. Cir. 1992) 91-1318; In re Laskowski, 10 U.S.P.Q. 2d 1397, 1299 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

The decision of In re Geiger, 2 U.S.P.Q. 2d 1276 (1987) is quite relevant. There, the Federal Circuit stated:

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.”

* * *

“At best in view of these [prior art] disclosures, one skilled in the art might find it obvious to try various combinations of these known [agents]. However, this is not the standard of 35 U.S.C. Section 103.”

In view of the foregoing, it is respectfully submitted that one of ordinary skill in the art, after reading and understanding Ananikian et al., would not even turn to Jensen – and if he did, he would not even achieve the present invention as claimed in claims 1, 10, and 11.

Since claims 2-9 depend from claim 1, the foregoing discussion of claim 1 is equally applicable to claims 2-9 and the allowance of claims 2-9 is respectfully solicited for the reasons given above with respect to claim 1.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of the applicant's undersigned attorney and, in the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

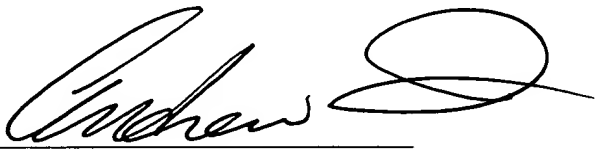
Applicant's representative agrees with the Examiner's implicit finding that the prior art made of record and not relied upon is not as relevant to the claimed invention as Ananikian et al. and Jensen.

Accordingly, it is respectfully maintained that all rejections and objections have been overcome, and that the present application is now in condition for formal allowance.

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Applicant believes no fee is due. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. **NY-GRYN 204 (10109100)** from which the undersigned is authorized to draw.

Respectfully submitted,

By 

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